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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ZARE, SCOTT A	
ART UNIT	**PAPER NUMBER**
3687	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/775,129	SAKAMOTO ET AL.	
	Examiner	Art Unit	
	SCOTT A. ZARE	3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-4, 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by *Horwitz et al.* (US 6,496,806).

In regard to claim 1, *Horwitz* discloses a tag grouping system comprising:

- parameter storage means (see column 8, lines 17-24, disclosing the central database) for storing a parameter which represents a measure of a strength of relationship among a plurality of ID tags (see column 6, lines 51-61, disclosing "the threshold number of items" used to determine if a plurality of ID tags are contained in a related cluster);
- parameter adjusting means for increasing and decreasing values of the parameter according to the number of pieces of ID information detected simultaneously in the ID tags by a mobile tag reader (see column 6, lines 51-

column 7, line 5, indicating that the threshold number can be adjusted based on a desired balance between acceptable read rates and certainty); and

- judging means for judging a plurality of ID tags as belonging to the same group according to values of the parameter stored in the parameter storage means (see column 6, lines 42-45. disclosing "if the read contains more than a threshold number of tags belonging to a particular cluster, then that cluster is said to be present").
- wherein when ID information is first detected simultaneously in a pair of ID tags, the parameter adjusting means newly sets the parameter for the ID tags to indicate the measure of relationship between of ID tags (see column 7, lines 10-14, indicating that after the cluster ID is associated with all of the tag ID, the threshold number can be set; see also column 6, line 50 - column 7, line 10).

It should be noted that "parameter" has been broadly interpreted to mean –a characteristic or element–.

In regard to claim 3, *Horwitz* further discloses the tag grouping system wherein when ID information is detected in a plurality of ID tags, the parameter adjusting means increases the values of the parameter stored in the parameter storage means. (See column 7, lines 10-14, indicating that after the cluster ID is associated with all of the tag ID, the threshold number can be set (i.e., increased in value); see also column 6, line 50 - column 7, line 10)

In regard to claim 4, *Horwitz* also discloses wherein **if** ID information is detected only in one of a pair of ID tags which has been registered in the parameter storage means, the parameter adjusting means decreases the parameter value of one of the ID tags of the pair of ID tags. (See column 7, lines 10-14, indicating that after the cluster ID is associated with all of the tag ID, the threshold number can be set (i.e., decreased in value); see also column 6, line 50 - column 7, line 10)

It should be noted that the claim language of claim 4 includes the use of a conditional element. Applicant is reminded that optional or conditional elements (i.e., "if ID information is detected in only in one of a pair of ID tags which has been registered in the parameter storage means") do not narrow the claims because they can always be omitted. *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006). "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim of claim limitation." MPEP §2106(II)(C) [Emphasis in original].

If a positive recitation is desired and if Applicant(s)' original specification supports such an amendment, the Examiner respectfully suggests amending the claim to recite, e.g., "when ID information is detected."

In regard to claim 6, *Horwitz* shows the tag grouping system according to claim 1, wherein when a value of the parameter stored in the parameter storage means exceeds

a predetermined threshold, the judging means judges that the ID tags relevant to the parameter value belong to a same group. (See column 8, lines 25-50.)

In regard to claim 7, *Horwitz* shows a tag grouping method for judging a plurality of ID tags as belonging to a same group according to values of a parameter which represents a measure of the strength of relationship among the plurality of ID tags, comprising:

a parameter setting step of newly setting the parameter for a pair of ID tags when ID information is first detected simultaneously in the pair of ID tags. (See column 7, lines 10-14, indicating that after the cluster ID is associated with all of the tag ID, the threshold number can be set; see also column 6, line 50 - column 7, line 10.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Horwitz* in view of Examiner's Official Notice.

In regard to claim 5, *Horwitz* shows the tag grouping system according to claim 2, wherein when a value of the parameter stored in the parameter storage cannot be zero.

(See column 7, lines 1-5, disclosing that the threshold number may be as low as 1.) In Horwitz, if the threshold number is set to zero, no threshold would exist and no relationship between items would be determined.

Examiner takes Official Notice that it is notoriously old and well-known in the art of database management to clear a field in a database if the value in the field is zero. Thus, it would be obvious to one of ordinary skill in the art to modify the tag grouping system of *Horwitz* to clear the parameter setting when the parameter means is set to zero.

Response to Arguments

Applicant's arguments, see Applicant Arguments/Remarks Made in an Amendment, filed 10/14/2008, with respect to the rejection(s) of claim(s) 1, 3-7 under 35 U.S.C. §103 have been fully considered and are not persuasive.

Claim Rejections - 35 USC § 102

The cited reference of *Horwitz* has been traversed by applicant in that it lacks certain elements of applicant's claimed method. In regard to claim 1, Applicant argues that *Horwitz* does not disclose the following elements:

- parameter adjusting means for increasing and decreasing values of the parameter according a number of pieces of ID information detected simultaneously in the ID tags by a mobile tag reader;
- wherein when ID information is first detected simultaneously in a pair of ID tags, the parameter adjusting means newly sets the parameter for the pair of ID tags to indicate the measure of the strength of relationship between the pair of ID tags.

With respect to the parameter adjusting means, Applicant argues that the "the number of items detected by *Horwitz* is only used to determine whether all the items associated with a cluster can be assumed to be present, not to make any adjustment to any parameter which represents a measure of a strength of relationship among a plurality of ID tags." Examiner has relied upon a feature disclosed in *Horwitz* which allows the user to adjust a threshold number of ID tags which must be read in order to ascertain with an acceptable level of certainty that a cluster has been read.

This issue turns on the interpretation of the claim language. It should be noted that "during patent examination, the claims are given the broadest reasonable interpretation consistent with the specification." MPEP §904.01 and §2111, citing *In re Morris*, 127 F3d 1048 (Fed. Cir. 1997). In addition, "limitations appearing in the specification but not recited in the claim should not be read into the claim. See MPEP §2106, citing *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003). Thus, under its broadest reasonable interpretation, the "parameter adjusting means" is construed to merely require a means to adjust (increase or decrease) a parameter. Under such an interpretation, adjusting a threshold number of items reads on the element. Applicant further argues that, according to claim 1, the parameter must "represent a measure of strength of relationship among a plurality of ID tags." In response to this argument, Examiner takes the position that the determining whether the items associated with a cluster are present correlates to "a measure of

strength of relationship among a plurality of ID tags." (i.e., the cluster is determined to be present or not present).

With respect to –wherein when ID information is first detected simultaneously in a par of ID tags, the parameter adjusting means newly sets the parameter for the pair of ID tags to indicate the measure of the strength of relationship between the pair of ID tags–, under its broadest reasonable interpretation, this claim element is construed merely require the ability to newly set the threshold "when ID information is first detected." Applicant argues that *Horwitz* fails to disclose the "setting of relationships parameters based on simultaneous detection of a pair of ID tags." However, *Horwitz* clearly discloses newly setting the parameter. In regard to the timing of setting the parameter (i.e., when), *Horwitz* teaches that the parameter may be set anytime (see column 6, line 50 – column 7, line 5), including "when ID information is first detected simultaneously in a pair of ID tags." Thus, based on such an interpretation, applicant's argument is without merit.

Furthermore, it should be noted that the "wherein" clause merely states the result of the limitations in the claim and consequently adds nothing to the patentability or substance of the claim. Thus, the "wherein" limitation is given little patentable weight. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Claim Rejections - 35 USC § 103

The rejections under 35 USC §103 have been traversed. Applicant argues that because *Horwitz* does not anticipate the independent claims, all further limitations found in dependent claims must also be allowable. However, based on the above 35 USC §102 analysis, the *Horwitz* reference has been found to anticipate claim 1. Thus, this argument is not persuasive.

Examiner's Assertion of Official Notice

To adequately traverse a factual assertion that is officially noticed, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I[n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.") A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice is inadequate. See MPEP §2144.03(C). Because applicant has failed to traverse the examiner's assertion of official notice, the following notoriously old and well-known in the art statements are taken to be admitted prior art:

- clearing a field in a database if the value in the field is zero

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT A. ZARE whose telephone number is (571)270-3266. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matt Gart can be reached on (571) 272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art Unit 3687

Scott A. Zare
Art Unit 3687
December 22, 2008